

## REMARKS

### **Summary of Office Action**

As an initial matter, Applicants note the Examiner has again failed to acknowledge the claim for foreign priority and the receipt of a copy of the certified copy of the priority document from the International Bureau in the Office Action Summary. Accordingly, the Examiner is again respectfully requested to acknowledge the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) and the receipt of a copy of the certified copy of the priority document in the next official communication by checking the appropriate boxes in the Office Action Summary.

Claims 39 and 44 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 39-41 and 44 remain rejected under 35 U.S.C. § 112, first paragraph, as allegedly partially failing to comply with the enablement requirement.

Claims 14-30, 32-37 and 39-44 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stab et al., US 2006/0093633 A1 (hereafter "STAB"), in view of Max et al., US 2005/0158350 A1 (hereafter "MAX").

### **Response to Office Action**

Reconsideration and withdrawal of the rejections of record are again respectfully requested, in view of the following remarks.

***Response to Rejections under 35 U.S.C. § 112, Second Paragraph***

Claims 39 and 44 remain rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection again alleges that it is unclear what “for protecting skin in cases of sensitively determined and dry skin” and “functional disorders of skin appendages” means.

Applicants again respectfully traverse this rejection for all of the reasons which are set forth in the response to the previous Office Action. The corresponding remarks are expressly incorporated herein.

Applicants still are of the opinion that the instant rejection under 35 U.S.C. § 112, second paragraph, is unwarranted and should be withdrawn, which action is again respectfully requested.

***Response to Rejections under 35 U.S.C. § 112, First Paragraph***

Claims 39-41 and 44 remain rejected under 35 U.S.C. § 112, first paragraph, as allegedly partially failing to comply with the enablement requirement. The rejection again alleges that the specification, while being enabling for treating inflammatory skin conditions, treating symptoms of intrinsic and extrinsic skin aging, treating harmful effects of ultraviolet radiation on skin, treating pigment disorders of the skin and treating functional disorders of the skin, does not reasonably provide enablement for preventing (inflammatory?) skin conditions, preventing symptoms of intrinsic and extrinsic skin aging, preventing harmful effects of ultraviolet radiation on skin, preventing pigment disorders of the skin or preventing functional disorders of the skin.

Applicants again respectfully traverse this rejection for all of the reasons which are set forth in the response to the previous Office Action. The corresponding remarks (which for the most part have not been commented on by the Examiner) are expressly incorporated herein.

Applicants still are of the opinion that the instant rejection under 35 U.S.C. § 112, second paragraph, is unwarranted and should be withdrawn, which action is again respectfully requested.

***Response to Rejection under 35 U.S.C. § 103(a)***

Claims 14-30, 32-37 and 39-44 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over STAB in view of MAX. In response to the arguments set forth by Applicants in the reply to the previous Office Action, the Examiner insists that both STAB and MAX qualify as prior art under 35 U.S.C. § 102(e).

Applicants again respectfully disagree with the Examiner in this regard, at least as far as STAB is concerned

In particular, the effective U.S. filing date of the present application is November 22, 2004, i.e., the filing date of International Application PCT/EP04/13254.

STAB is the National Stage of PCT/EP03/05347. While the filing date of PCT/EP03/05347 (May 22, 2003) predates the effective filing date of the present application, PCT/EP03/05347 was published in German, wherefore STAB is not entitled to any date under 35 U.S.C. § 102(e).

In this regard, the Examiner's attention is directed to 35 U.S.C. § 102(e), which provides (emphasis added):

A person shall be entitled to a patent unless —

(e) the invention was described in —

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States **only** if the international application designated the United States and was published under Article 21(2) of such treaty **in the English language**;

Accordingly, STAB clearly does not qualify as prior art under 35 U.S.C. § 102(e) and for this reason alone, the instant rejection is necessarily without merit.

However, merely in order to expedite the issuance of a patent and to also disqualify MAX as prior art under 35 U.S.C. § 102(e), Applicants herewith submit a verified English language translation of the application of which the instant application claims priority, i.e., German Patent Application No. 103 57 451.4, filed December 3, 2003 (i.e., before the filing date of MAX, October 18, 2004). Since it is believed that all of the present claims are supported by the German priority application not only STAB but also MAX is unavailable as prior art with respect to the instant claims.

It is submitted that for at least the foregoing reasons, withdrawal of the instant rejection under 35 U.S.C. § 103(a) is warranted and again respectfully requested.

**CONCLUSION**

In view of the foregoing, it is believed that all claims of record are in condition for allowance. Accordingly, an early issuance of the Notices of Allowance and Allowability is respectfully solicited. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,  
Stefan GALLINAT et al.

/Heribert F. Muensterer/

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